

### **REMARKS**

Claims 1 and 3-16 are pending in the present application. Claims 6-8, 10-13, and 16 have been withdrawn from consideration. Claim 1 has been amended to recite the limitations of claim 2 and claim 2 has been canceled accordingly. Applicants submit that this claim amendment does not raise new issues or require a new search since the amendment to claim 1 incorporates subject matter that has already been examined.

Claims 1-5 stand rejected as being allegedly anticipated by U.S. Patent No. 6,015,410 to Tormala ("Tormala"). Claims 1-5, 9 and 14 stand rejected under 35 USC 103(a) as being allegedly rendered obvious by U.S. Patent No. 5,167,664 to Hodorek ("Hodorek") in view of U.S. Patent No. 6,666,868 to Fallin ("Fallin"). Applicants respectfully traverse these rejections.

#### **Claims 1-5 are Not Anticipated by Tormala**

According to the Examiner, Tormala shows corners of a triangle recess of a screw with "some degree of roundishness." Without addressing the merits of this argument, Applicants submit that the corners depicted in Tormala are still triangles and therefore are not "ovals, circles, or rectangles with rounded edges," which are the specific shapes of the lobes recited by amended claim 1 (even if the triangle of Tormala is considered to have roundish edges, such a configuration is not an oval, circle or rectangle with rounded edges under the well accepted definitions of these geometric shapes). For at least this reason, Applicants submit that claims 1-5 are not anticipated by Tormala and Applicants request withdrawal of this rejection. Applicants point out that this added limitation was originally present in claim 2 and the Examiner never directly addressed this limitation. The Examiner states that Figure 4b of Tormala "shows corners of the triangle with some degree of roundishness and this roundishness could be formed by a circle or oval located upon the triangle corners." However, amended claim 1 specifically recites that the lobes are ovals, circles, or rectangles with rounded edges and the shape of the lobe of Tormala is not any of these shapes.

#### **Claims 1, 9, and 14 Are Not Rendered Obvious By Hodorek in view of Fallin**

Claims 1, 9 and 14 recite a "one-piece" surgical screw. Hodorek, in contrast, describes a two-piece surgical screw. Throughout the specification, Hodorek refers to the screw as "two piece." For examples, Hodorek describes "a two piece bone screw having a separate head and

shaft. . .” (*see* Abstract); “The bone screw of this invention includes a two piece screw” (col. 1, lines 27-28); “Two piece bone screw 30 includes a shaft 32 and a head 34.” (col. 2, lines 50-51).

The Examiner submits that the whole bone screw, i.e. the combination of all elements, can be considered one-piece since the several parts are rigidly secured together as a single unit or piece.” As such, the Examiner is ascribing the same meaning to the terms “one piece” and “single unit.” Such an interpretation is inconsistent with the plain meaning of the term “piece.” The claims do not recite a screw that is a single unit, rather the claims specifically recite a “one piece” surgical screw. The Examiner cites to the case *In re Larson* to allegedly support this position. However, *In re Larson* involved the term “integral” and not “one-piece,” and the Examiner’s statements were made by the court specifically in reference to the term “integral.” In fact, the court specifically distinguished the term “single piece” from “single unit,” indicating that these terms are not interchangeable. Specifically, the court stated “the term ‘integral’ is not limited to fabrication of the parts from a single piece of metal, but is inclusive of other means for maintaining the parts fixed together as a single unit.” *See In re Larson*, 52 C.C.P.A. 930, 933 (C.C.P.A. 1965) (*emphasis added*). Therefore, it is Applicants position that this case in no way supports the Examiner’s position and Applicants submit that a “one piece” surgical screw is not a “two piece” surgical screw notwithstanding whether the two piece surgical screw ultimately forms a single unit.

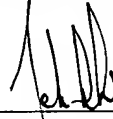
Furthermore, as stated in the previous response, there is no suggestion or motivation to modify the screw of Hoderek to be a one-piece surgical screw, since doing so would change the principle of operation of Hoderek. Specifically, the head and shaft of Hoderek’s screw include a plurality of teeth that mutually engage to permit the head to shift relative to the shaft (See Abstract). If the head and shaft were one piece, the head and shaft could not move relative to each other. As such, Applicants submit that Hoderek does not teach or suggest a one-piece surgical screw. For at least this reason, Applicants submit that Hoderek does not render obvious claims 1, 9, and 14 (and all claims that depend therefrom) and Applicants request withdrawal of this rejection.

**CONCLUSION**

It is respectfully submitted that the present application is now in condition for allowance, which action is respectfully requested. The Examiner is invited to contact Applicants' representative to discuss any issue that would expedite allowance of the subject application.

Any fees for extension(s) of time or additional fees are required in connection with the filing of this response, such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is authorized to charge any such required fees or to credit any overpayment to Kenyon & Kenyon's Deposit Account No. 11-0600.

Respectfully submitted,  
KENYON & KENYON



Dated: March 17 2005

By: Zeba Ali  
(Reg. No. 51,392)

1500 K Street, N.W.  
Washington, D.C. 20005  
Tel: (202) 220-4200  
Fax: (202) 220-4201